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IN THE
Supreme Court of the United States

OCTOBER TERM, 1942

No. 219

R. PICARD, INDIVIDUALLY AND AS ADMINISTRATRIX OF THE
ESTATE OF M. J. SCHENK, DECEASED, ET. AL.,
Petitioners,

vs.

UNITED AIRCRAFT CORPORATION,
Respondent.

**BRIEF FOR RESPONDENT ON PETITION
FOR WRIT OF CERTIORARI**

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Plaintiffs in a patent suit were defeated below because the Circuit Court of Appeals for the Second Circuit (opinion reported, 128 F. 2d 632) held "that the claims in suit are all invalid for lack of invention" (Rec. 1039, fol. 3115).

The District Court (43 F. Supp. 679) had dismissed the complaint as to all but two claims (4 and 14); upon defendant's appeal the Court of Appeals reversed as to those, and otherwise affirmed (Rec. 1049), holding all claims in issue to be invalid (Rec. 1039).

There has been no litigation in any other Circuit, nor any other action brought upon the patent. Thus the issue presented by the petition is, fundamentally, whether, all conflict being absent, this Court will review a simple holding by the Court of Appeals that a patent is invalid for lack of invention over the prior art, the Court having reached that conclusion.

Nor is this a case where it is asserted that the only infringements are within a single Circuit. So far as appears—and we believe the fact to be—many airplane engine builders in various parts of the country have been building their engines substantially in the way here charged to infringe.

Plaintiffs seek review for the stated reasons *first*: that the Court of Appeals pronounced and applied to the patent a standard of invention which it believed to be in accord with “ ‘a pronounced new doctrinal trend’ ” by which this Court has “ ‘shown an increasing disposition to raise the standard of originality necessary for a patent’ ” (Petition, p. 9); *second*: because the question so presented, with respect to earlier precedents, is asserted to be of importance sufficient to justify its settlement by this Court (Petition, p. 10); and *third*: because, if this Court has *not* so raised the standard of invention, plaintiffs assert that the Schenk patent would represent a patentable advance (Petition, p. 11).

We urge that the petition should be denied *first*: because petitioners’ stated reasons do not fairly reflect either the position or the opinion of the Court of Appeals (Rec. 1038); and *second*: because we feel that petitioners’ stated reasons do not accurately reflect the holdings of this Court, whether during the last decade or before.

I.

Petitioners have incompletely and incorrectly stated the opinion and holding of the Court of Appeals.

The petition assumes throughout, and in several places seems to assert (p. 2, bottom; p. 7, question 1), that the patentee, Schenk, was the creator of automatic lubrication for the valve gear of air-cooled radial engines such as are used on airplanes today, and for that reason made what

should be held to be a patentable invention. This is a fundamental error. The Court of Appeals found, expressly, and many of its findings were concurrent with those of the district court (*e. g.* Rec. 1041, fol. 3123), that Schenk's disclosure, although an improvement, was no more than that (Rec. 1044, fol. 3131). It was held not to amount to invention (Rec. 1045). What it did amount to, at the most, and stated by reference to the findings of the Court of Appeals, was simply this:

Completely automatic oiling systems for the valve gear of airplane engines were old before Schenk, both in air-cooled *radial* engines and in *V-type* engines.¹ Upon Schenk's own statement, the difficulties were common to both radial and vertical (in-line) engines (Rec. 1045, fol. 3134). In neither type of engine was there anything new in the mechanism for leading the oil from the oil pump *out* through the push rods and rocker arms to the joint between valve stem and rocker arm, thus accomplishing all desired lubrication. That was all found (and conceded by plaintiffs, in the Court of Appeals) to be old (Rec. 1040, fols. 3120-3122). If there *were* any invention, it could *only* be in the mechanism for draining the oil back from the rocker-arm boxes to a sump below the lowermost of the cylinders—as was also found by the Court of Appeals (Rec. 1041, fol. 3122; 1045, fol. 3134). As to that, the situation was that it was old in the Curtiss R-1454 engines—designed by Heron for the U. S. Government and three of which were tested, accepted and bought by the Government (Rec. 1041-3), and which must be considered a part of the prior art (Rec. 1042, fol. 3126)—to drain the rocker-arm boxes by *suction* to a “*sump-pump*”

¹ *I. e.* engines in which the cylinders are arranged in line, one behind the other, in two or more mutually-inclined banks, forming a “V”, like two spokes of a wheel; while in a “radial” engine the cylinders form a complete circle, like all the spokes (Rec. 1039, fol. 3116).

(Rec. 636-7; 663). That engine was not an abandoned experiment (Rec. 1041, fol. 3123; 1043, fol. 3128); and, whatever its defects in parts not here material, they were *not* with respect to its valve-gear lubrication system (Rec. 1042, fol. 3124). Thus *suction* return drainage of the valve oil, through a complete circular manifold to a sump-pump, in a radial, air-cooled, airplane engine, is established as part of the prior art (Rec. 1042, middle; 1043, fol. 3129). And *gravity* drainage, by manifolds to a pump below the lowermost cylinders, was also old (Rec. 1044, fols. 3130-1)—for example in the Packard inverted V-type engines which are shown in the Woolson patent (Rec. 892; 926). That was an engine in which the cylinders, arranged in two mutually-inclined banks, thus making a partial rather than a complete circle, were inverted like the two lowermost spokes of a wheel; and oil from the valve rocker boxes was drained by manifolds 36, and thence delivered to the oil reservoir by the pump 37, located behind 27 in Fig. 2, as the Court of Appeals found (Rec. 1043-4).

The Court of Appeals found that that engine "filled the hiatus" (Rec. 1043, bottom); the prior art had had *suction* drainage of a radial engine (helped by gravity in the case of the upper boxes), in the case of the Curtiss engine, and *gravity* drainage of an inverted V-type engine in this Packard construction (Rec. 1044, fol. 3130). Gravity drainage to an oil sump below the cylinders was also old in the Hispano-Suiza airplane engine (Rec. 929), in which the gravity-drained oil is shown in red at the bottom of the page, and there is also a separate oil tank (*i. e.* reservoir or sump), shown at the right.

Thus the most that Schenk can be said to have done was to apply gravity drainage, to a sump below the lowermost cylinders, to a radial engine; and on that we have his own statement that the difficulties were common to the radial and the in-line engines (Rec. 1045, fol. 3134), upon the latter of which (Woolson-Packard; Hispano-Suiza) that very thing had already been done.

What was presented to the Court of Appeals, then, was a simple case in which the engine itself and its valve gear, all suitably enclosed and hand-lubricated by grease, were old, and were in fact copied by the patentee from *respondent's* earlier engines (Rec. 1041, top). The *outgoing* train of oil passages, for application of automatic lubrication to the valve gear, was also admittedly old (Rec. 1040, fol. 3120); so that novelty, if any, could exist only in the return drainage arrangements (Rec. 1041, fol. 3122). For that, a complete circular manifold for a radial engine, with *suction* to a sump-pump (Rec. 636-7; 663), aided by gravity in the case of the upper boxes, was old in the Army's Curtiss engines; a *gravity* drain by manifolds to a pump below the cylinders, thence returned to a separate reservoir, was old in the Packard (Woolson) inverted V-type engines; and a separate sump below the lowermost cylinders, for gravity drainage, was old in many engines—*e. g.* the *Hispano-Suiza* airplane engine (Rec. 929)—wherever gravity drainage was wanted.

How then, there being no conflict and, in fact, no other litigation on the patent, can it be said that the Court of Appeals, in holding non-invention upon such a record, decided the case "in a way probably in conflict with applicable decisions" of this Court (Petition, p. 9)? We think that, such being the showing of the prior art, the holding of the Court of Appeals was plainly in harmony with the decisions of this Court, not alone during the decade just passed but in a continuous course since the passage of the present act over 100 years ago. This we shall show, as our second point.

II.

Holding of Court of Appeals was in accord with applicable decisions of this Court.

Gravity and suction having been alike old, and known alternatives, as means for draining return oil in airplane engines, as was also an oil sump below the lowermost point to be drained:

It seems clear that no "flash of creative genius" was revealed, as distinguished from the mere skill of any designer, in applying one rather than the other. Hence the holding below was within *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84 at page 91, middle, in which both ancient and modern cases are cited.

The holding is within the principles of, and entirely consistent with, *Standard Brands, Inc. v. National Grain Yeast Corp.*, 308 U. S. 34 at page 37, top; *Toledo Pressed Steel Co. v. Standard Parts, Inc.*, 307 U. S. 350 at page 356, top; *Honolulu Oil Corp. et al. v. Halliburton et al.*, 306 U. S. 550 at page 559, middle; *Mantle Lamp Co. v. Aluminum Products Co.*, 301 U. S. 544 at page 546.

"The choice was one between alternative means obvious to any mechanic; it did not have the quality of invention,"

within the holding of *Essex Razor Blade Corp. v. Gillette Safety Razor Co.*, 299 U. S. 94 at page 98, bottom.

What was done by petitioner here was certainly no more than the addition of the old flywheel in *Altoona Public Theatres, Inc. v. American Tri-Ergon Corp. et al.*, 294 U. S. 477 at pages 482-4; or printing the sound and picture tracks previously separately exposed and developed, together on one positive, as in *Paramount Public Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464 at pages 470-3.

What petitioner asserts as the advance is of the same order as the addition of the oil reservoir in *Electric Cable*

Joint Co. v. Brooklyn Edison Co., Inc., 292 U. S. 69 at pages 79-80—held not to be patentable. It is certainly less than was involved in the “high vacuum case”—which petitioner does not mention—*DeForest Radio Co. v. General Electric Co.*, 283 U. S. 664 at pages 678 and following, and pages 681-2.

Many other decisions of this Court are discussed by petitioner (Petition, pp. 18-30); but it seems that an analysis of each would be superfluous, both because the cases are fully illustrated by those already referred to, and because petitioners’ assertion concerning the others does not appear to be at variance with what we have said about those mentioned.

The whole basis of petitioners’ argument is that the Court of Appeals applied a standard of invention different from and higher than that laid down in the cases referred to (Petition, p. 23). We think that a full statement of the issue of invention, as it was actually presented to the Court of Appeals here, shows that the decision was in *accord* with the holdings of this Court, whether examined for the last decade only, or for the last hundred years.

Conclusion.

No reason for review by this Court is shown, since the decision below was simply an ordinary holding of lack of invention over the prior art, by a Court of Appeals on a full record, and without conflict. The petition does not accurately represent either the position of the Court of Appeals or the application to the facts established by this record of the pertinent decisions of this Court. We submit that the petition should be denied.

Respectfully submitted,

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